REMARKS

Before applicant further contemplates an appeal, it is believed that the Examiner may want to reconsider the rejection of claims in the office action of March 26, 2007.

The Examiner purports to base her rejection on provisional application 60/248454, but in reality rejects claims of the application on the entirety of Chung U.S. 2004/0036623, most of which as the Examiner knows has a priority date well after the date of September 19, 2001 as has been established herein by applicant. Most of the specific references to Chung '623 by the Examiner are not disclosed in, apparent from or even hinted at on in the provisional application '454.

Attached hereto as an Exhibit is an annotated copy of pages 2-12 of the Examiner's rejections of claims in this application. The same has been annotated to identify those components and statements in Chung '623 used by the Examiner which are not disclosed at all in '454.

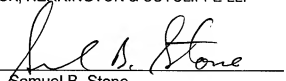
Thus, the Examiner's rejections of claims herein is faulty. Reconsideration by the Examiner is requested.

The Commissioner is authorized to charge Orrick's Deposit Account No. **150665** for any fees necessary in connection with this response.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: April 10, 2007

By: 

Samuel B. Stone
Reg. No. 19,297

Orrick, Herrington & Sutcliffe LLP
4 Park Plaza, Suite 1600
Irvine, CA 92614-2558
Tel. 949-567-6700
Fax: 949-567-6710

EXHIBIT

Claim Rejections - 35 USC § 103

Claims 55-59 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (US 2004/0036623). **[Filing date 10/09/2001, after applicant's established date of 09/19/2001]**

Claim 55:

Chung discloses a method for monitoring administration **[no, merely delivery of medicine at a pharmacy]** of a medical product to a patient, the medical product comprising a Radio Frequency identification (RFID) tag for storing data related to the medical product, the method comprising:

a. reading the RFID tag 200 **[tag 200 not disclosed in 60/248,454]** associated with the medical product to obtain the data stored in the RFID tag when the medical product passes along a transport path.

b. accessing data associated with a patient, and verifying that the patient is intended to receive the medical product by comparing the data obtained from the RFID tag with the data associated with the patient (para. [0042].) **[Not in '454; NEW in PCT Application of 10/09/2001]**

See fig. 6 **[most of Fig. 6 is in '454, but not blades 42 and 200-M]** and page 12, para. [0132] to page 14, para. [0136]. **[Not in '454]**

It is not clearly stated that the data stored in the RFID tag is obtained when the product passes through an entrance to the patient's room. Nonetheless, the reference suggests that the product (tracked object) is tracked along a transport path. Thus, it would have been obvious to one skilled in the art to read the object RIFD in Chung as it passes the entrance of a patient's room because the system is intended for use to verify that the medication should be administered to the right patient. **[Not stated at all; no**

disclosure of any patient room, hospital, etc.; just delivery of medicine at pharmacy]

Claim 56:

The verifying step disclosed in Chung's further comprises comparing a product identifier from the data obtained from the RFID tag with a product identifier from the data associated with the patient.

Claim 57:

In Chung's, the product identifier comprises at least one of a product name, a dosage, and a product serial number.

Claim 58:

The method in Chung's further comprises displaying **[not displayed]** a mismatch notification when there is a mismatch between the data obtained from the RFID tag and the data associated with the patient. Para. [0138]. **[Not in '454]**

Claim 59:

Chung's method further comprises activating an output device when there is a mismatch between the data obtained from the RFID tag and the data associated with the patient. Para. [0138]. **[Not in '454]**

Claims 1-10, 30-54, and 60-70 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (US 2004/0036623) in view Issacman et al. (US Patent No. 6,127,928).

Claim 1:

Chung discloses an apparatus for monitoring administration of medical products to a patient, each of the medical products comprising a RFID tag 200 for storing data related to the respective medical product, the apparatus comprising:

a. A reader 42 **[42 is not in '454]** for reading RFID tags associated with a plurality of medical products placed in close proximity to the reader to obtain the data stored in the RFID tags;

b. A processor 30 **[not in '454]** coupled to the reader for processing data obtained from the RFID tags to identify the medical products.

The reference fails to disclose substantially simultaneously reading **[fails is correct]** the RFID tags. However, this feature is well known in the art as taught in Issacman (col. 7, last paragraph) **[no, he specifically discloses "sequentially" not simultaneously]**. In light of this teaching, it would have been obvious to a skilled artisan to readily recognized using a tag reader with ability to read multiple tags substantially simultaneously as in Issacman's in the Chung system because it would be advantageous and desirable to read several tags at the same time.

See figs. 3 **[not in '454]** and 6 and page 12, para. [0132] to page 4, para. [0136]. **[Not in '454]**

Claim 2:

The Chung system has a memory coupled to the processor 30 [no] for storing data associated with patient. See front-page figure. **[Not in '454]**

Claim 3:

The processor in Chung's system compares the product identifiers from the data obtain from the RFID tags with product identifiers from the data associated with the patient.

Claim 4:

The product identifiers used in Chung's is one of the product names and dosages. Para. [0056]. **[0056 not in '454]**

Claim 5:

A display 50 **[not in '454]** is coupled to the processor 30. See fig. 3. **[Not in '454]**

Claim 6:

Chung discloses an output device coupled to the processor **[not in '454]**, and wherein the processor activates the output device when the processor detects a mismatch between the data obtained from the RFID tags and the data associated with the patient. See fig. 5B **[not in '454]** and [0136]. **[Not in '454]**

Claim 7:

The output device in the Chung system is a display 50 **[not in '454]** which is functionally equivalent to the at least one of a light indicator or an audio indicator. Furthermore, the use of a light or an audio indicator to provide a warning would not constitute an inventive concept because they are conventional in the art.

Claim 8:

It is not clearly stated **[it is not stated at all]** in Chung's that the data stored in the RFID tag is obtained when the product passes through an entrance to the patient's room. Nonetheless, the reference suggests that the product (tracked object) is tracked

along a transport path. Thus, it would have been obvious to one skilled in the art to read the object RIFD in Chung as it passes the entrance of a patient's room **[not so; only tracks at pharmacy]** because the system is intended for use to verify that the medication should be administer to the right patient.

Claims 9 and 10:

In the combined system of Chung and Issacman, it would have been obvious to one skilled in the art to use a read pad to provide a surface **[not disclosed]** for placing the medical products because the use of a read pad would allow the products to be read simultaneously more easily though not necessary. **[No disclosures at all; only sequential]**

Claim 30:

Chung discloses an apparatus thus a method for identifying a plurality of medical products, each of the medical products comprising a for storing data related to the respective medical product, the method comprising:

a. placing the plurality of medical products in close proximity to a RF antenna;

b. reading the Radio Frequency identification (RFID) tags associated with the medical products using the RF antenna to obtain the data stored in the RFID tags; and

c. identifying each of the plurality of medical products based upon the data obtained from the RFID tags.

See front-page figure. **[Not in '454]**

The reference fails to disclose substantially simultaneously reading the RFID tags. However, this feature is well known in the art as taught in Issacman (col. 7, last paragraph) **[no, he specifically discloses "sequentially" not simultaneously]**. In

light of this teaching, it would have been obvious to a skilled artisan to readily recognized using a tag reader with ability to read multiple tags substantially simultaneously **[no]** as in Issacman's in the Chung system because it would be advantageous and desirable to read several tags at the same time.

Claim 31:

The method in Chung's further comprises recording administration of the identified medical products to a patient using tag 200-Rx. **[200-Rx not disclosed in '454]**

Claim 32:

The identifying step in Chung's comprises accessing a database **[not in '454]** to obtain data associated with the medical products based upon the data obtained from the RFID tags.

Claim 33:

It is not clear in Chung's that the data obtained from the RFID includes location identifiers **[nothing like this in '454]**. However, it would have been obvious to one skilled in the art to configure the system to relate the product's location with the database **[no disclosure in '454]** to retrieve the product's information as desired. This feature would not be considered as an inventive step because it only presents a choice in design.

Claim 34:

The step in Chung's includes verifying that the patient is intended to receive the plurality of medical products by comparing the data obtained from the RFID tags with the data associated with the patient. See fig. 6 and para. [0136]. **[0136 not in '454]**

Claim 35:

The Chung system includes a patient RFID tag 200-Rx **[200-Rx not in '454]** for uniquely identifying a patient intended to receive a medical product.

Claims 36-37:

It is not clearly stated in Chung's that the data stored in the RFID tag is obtained when the product passes through an entrance to the patient's room **[no disclosure in '454 at all]**. Nonetheless, the reference suggests that the product (tracked object) is tracked along a transport path. Thus, it would have been obvious to one skilled in the art to read the object RIFD in Chung as it passes the entrance of a patient's room because the system is intended for use to verify that the medication should be administer to the right patient. **[Not stated at all; no disclosure of any patient room, hospital, etc.; just delivery of medicine at pharmacy]**

Claim 38:

Chung suggests the use of the system in a healthcare pharmacy **[absolutely not in '454]**; therefore, a transport path in Chung could include the pharmacy doorway. Further, the use of the combined system in Chung's and Issacman's in a pharmacy would not alter the function of the device, thus, this feature does not present a novel or inventive step.

Claims 39:

Chung discloses an apparatus for monitoring administration of medical products to a patient, each of the medical products comprising a RFID tag 124a **[124a not in '454]** for storing data related to the respective medical product, the apparatus comprising:

c. A reader 42 **[42 not in '454]** for reading RFID tags associated with a plurality of medical products placed in close proximity **[not disclosed]** to the reader to obtain the data stored in the RFID tags;

d. A processor 30 **[not in '454]** coupled to the reader 42 for processing data obtained from the RFID tags to identify the medical products.

The reference fails to disclose substantially simultaneously reading **[fails is correct]** the RFID tags. However, this feature is well known in the art as taught in Issacman (col. 7, last paragraph) **[no, he specifically discloses "sequentially" not simultaneously]**. In light of this teaching, it would have been obvious to a skilled artisan to readily recognized using a tag reader with ability to read multiple tags substantially simultaneously as in Issacman's in the Chung system because it would be advantageous and desirable to read several tags at the same time.

Claim 40:

A display **[none in '454]** in Chung's is coupled to the processor 30 **[no]** and the processor inherently controls the display 50 **[no]** to display the identified medical products. See fig. 5B. **[Not in '454]**

Claim 41:

Chung further discloses a network interface 10 (see fig. 2) **[not in '454]** to the processor 30 **[not in '454]**, and wherein the processor is configured for transmitting data obtained from the RFID tags using the network interface. See fig. 2. **[Not in '454]**

Claim 42:

Processor 30 **[not in '454]** is configured for receiving a notification via network interface **[no]**, in response to the transmission **[no]**, indicating whether to administer the identified medical products. See fig. 2. **[Not in '454]**

Claim 43:

A display 50 **[not in '454]** is coupled to the processor 30 **[not in '454]**, and wherein the processor is configured for displaying [no] the received notification on the display.

Claim 44:

An output device, display 50 **[no]**, is coupled to the processor 30 **[no]**, and wherein the processor 30 **[no]** activates the output device when the received notification indicates that the identified medical products should not be administered. Fig. 5B **[not in '454]** and para. [0136]. **[Not in '454]**

Claim 45:

The output device in Chung does not include least one of a light indicator and an audio indicator. However, one skilled in the art would have readily recognized that display 50 **[not in '454]** provides an equivalent function of a light indicator to indicate an alarm condition.

Claims 46-52:

The rejection of claims 46-52 recites the rejection of claims 39-45.

Claim 53:

The reference fails to disclose substantially simultaneously reading the RFID tags. However, this feature is well known in the art as taught in Issacman (col. 7, last paragraph) **[no, he specifically discloses "sequentially" not simultaneously]**. In light of this teaching, it would have been obvious to a skilled artisan to readily recognized using a tag reader with ability to read multiple tags substantially simultaneously as in Issacman's in the Chung system because it would be advantageous and desirable to read several tags at the same time.

Claim 54:

Chung's method comprises reading the RFID tag associated with the medical product when the medical product is placed in close proximity to a reader. It is not clearly stated **[not stated at all in '454]** that the reader in the Chung system is a read pad; however, it would have been obvious to one skilled in the art to use a read pad in Chung' because it is functionally equivalent to the reader 42. **[Not in '454]**

Claim 60:

Chung's method comprises reading the RFID tag associated with the medical product when the medical product is placed in close proximity to a reader. It is not clearly stated that the reader in the Chung system is a read pad; however, it would have been obvious to one skilled in the art to use a read pad in Chung' because it is functionally equivalent to the reader 42. **[Not in '454]**

Claim 61:

It is not clear whether Chung records administration of the medical product to the patient **[not disclosed at all]** when there is a match between the data obtained from the RFID tags and the data associated with the patient. However, it would have been obvious to one skilled in the art to incorporate the idea into the Chung system because it would keep a record of the administering of the medical product to the particular patient for future purposes. **[Hindsight]**

Claim 62:

The Chung reference fails to disclose substantially simultaneously reading the RFID tags. However, this feature is well known in the art as taught in Issacman (col. 7, last paragraph) **[no, he specifically discloses "sequentially" not simultaneously]**. In light of this teaching, it would have been obvious to a skilled artisan to readily recognized using a tag reader with ability to read multiple tags substantially

simultaneously as in Issacman's in the system of Chung's because it would be advantageous and desirable to read several tags at the same time.

Claim 63:

The rejection of claim 63 recites the same rejection of claim 1, except it is a method claim.

Claims 64-67:

The rejection of claim 64-67 recites the same rejection of claims 3-6, except they are method claims.

Claim 68:

The rejection of claim 68 recites the same rejection of 8, except it is method claim.

Claim 69:

Chung's method comprises reading the RFID tag associated with the medical product when the medical product is placed in close proximity to a reader. It is not clearly stated that the reader in the Chung's system is a read pad; however, it would have been obvious to one skilled in the art to use a read pad in Chung's because it is functionally equivalent to the reader 42. **[Not in '454]**

Claim 70:

It is not clear whether Chung records administration of the medical product to the patient **[not disclosed]** when there is a match between the data obtained from the RFID tags and the data associated with the patient. However, it would have been obvious to one skilled in the art to incorporate the idea into the Chung system because it would keep a record of the administering of the medical product to the particular patient for future purposes.